

**REMARKS**

The present amendment is submitted in response to the Office Action dated October 10, 2003, which set a three-month period for response. Filed herewith is a Request for a One-month Extension of Time, making this amendment due by February 10, 2004.

Claims 1-17 are pending in this application.

In the Office Action, the specification and drawings were objected to for various informalities. Claims 1-4, 6, 9, 10, 12-14, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,909,183 to Borgstahl et al in view of U.S. Patent No. 5,554,980 to Hashimoto et al. Claims 5, 7, 8, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl in view of Hashimoto and further in view of U.S. Patent No. 5,917,405 to Joao.

The Applicant first wishes to note that in the Simultaneous Amendment filed March 29, 2001, original claims 1-17 were canceled and a set of 17 new claims was added, in which multiple claim dependencies were eliminated. However, these 17 new claims were numbered incorrectly as claims 1-17, rather than 18-34. Therefore, in this amendment, the cancelled status of original claims 1-17 is indicated and the pending claims have been renumbered as claims 18-34.

In the present amendment, the specification was amended to add standard section headings and to delete reference to the claims.

With regard to the objection to the specification relating to the lack of description of the steps in Figure 2, the Applicant respectfully disagrees and directs the Examiner's attention to page 7, line 26 through page 8, line 18. In this portion of the specification, reference is made to "blocks 30-34" of Figure 2, and each of the respective steps is described specifically.

Figure 2 was amended to add descriptive labels relating to the steps performed in the blank boxes.

The claims have been amended to adopt standard claim format. Specifically, method claim 18 was amended to claim a specific series of steps, and the dependent claims were amended to delete the "characterized in that" phrase and replace it with "wherein". The claims were amended further to provide proper antecedent for the claimed elements.

The Applicant notes that claim 11 (now claim 28) was not rejected over the cited references. Therefore, the Applicants has added new claim 35, which is claim 28 rewritten in independent form.

With regard to the substantive rejections of the claims, the Applicant respectfully disagrees that the cited reference combination of the Borgstahl and Hashimoto patents renders obvious the subject matter of claim 1.

As the Examiner admits in the Office Action, Borgstahl et al do not teach or suggest that the controller or controller device is associated with a navigation or position determining device, and especially, that the navigation or position determining device activates the controller to automatically connect it to its controlled entities, i.e., its appliances or the like.

Moreover, the communication between the remote device 34 of Borgstahl, considered as similar to the data terminal of the present invention, and the peers 20, considered as similar to the integrated household control system, is not based on proximity. Only the communication between the peers 20 is based on proximity.

Furthermore, the communication between the peers 20 is not based on the determination of the distance. Instead, the communication range of the peers 20 is indirectly based on low power. Therefore, the communication range of the peers 20 depends on the environment of the peers 20. On the other side, the communication between the remote device 34 and the peers 20 is established by gateways, like PSTN and the like, and is therefore not based on proximity.

Thus, Borgstahl neither suggests a communication between the remote device 34 and the peers 20 based on proximity nor based on distance.

The Examiner cites Borgstahl in combination with Hashimoto et al, and states that Hashimoto shows the features of the present invention not shown or disclosed by Borgstahl. The Applicant respectfully disagrees.

Hashimoto et al arguably disclose a remote control unit that sends a signal to a receiving device, and *vice versa*. The Hashimoto device includes a position-determining device that determines the relative position or orientation of the remote control unit to the receiving device. The determined relative position or orientation is converted into a signal in the receiver, which is used to position a cursor.

However, the position determining device does not function as claimed in claim 18 of the present application because it does not automatically initiate or make a connection between the remote control unit and the receiver according to a distance determined by the position determining device. In Hashimoto, the receiving unit seemingly must be connected to the remote control unit prior to positioning the cursor with it. Both units must be on and the connection between made prior to utilizing the navigation device.

In addition, the position determining device of Hashimoto (the sensor 75a) does not determine the distance. Rather, the two-dimensional CCD array of the sensor 75a is only capable of determining the (two-dimensional) position in order to produce a signal for moving a cursor.

Therefore, because neither of the references discloses or suggests the features of the present invention, as recited in claim 18, the rejection of the claim 18 under Section 103 cannot be maintained. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *In re Fritch*, 23 USPQ 1d 1780, 1783084 (Fed. Cir. 1992).

With regard to the rejection of claims 22, 24, 25, and 32 (formerly claims 5, 7, 8, and 15) under Section 103 as obvious over the combination of Borgstahl, Hashimoto and Joao, the Applicant respectfully disagrees with this rejection. The Examiner refers in the Office Action to Figure 1 of Joao and remarks that it shows a mobile data terminal or remote control unit arranged in a vehicle.

On the contrary, Joao's embodiment of Figure 1 shows an on-board control unit or computer controller 4 of a vehicle under control of a remote transmitter 2 for remote vehicle control and security purposes. With respect to Figure 1, Joao specifically teaches that the remote controller/transmitter 2 should not be connected physically to the remainder of the apparatus and should be separate and apart from the vehicle (column 3, lines 29-35).

Joao also teaches another embodiment for a mobile home or a home control system, which controls various home systems and appliances in column 61, line 44, to column 66 (Fig. 15). In this embodiment, a remote controller 2 is used to communicate with a receiver for a central computer 4 used in the mobile home or control system. The mobile home control system does have a navigation and position-determining device, but it is not connected to the remote controller or terminal; it is connected to the central computer of the mobile home control system to determine the location of the mobile home.

This is contrary, then, to the invention as defined in claim 29 and the method of claim 18. The Applicant respectfully submits that the Joao reference has been misinterpreted. The Joao reference never suggests that the remote terminal or controller should be used or carried in motor vehicle that necessarily has a navigation system, i.e., in the case of Joao, there is no need to know the position of the terminal or remote controller.

Moreover, the transmitter system 2 of Joao is not located in the motor vehicle (see column 18, lines 58-62, for example).

Therefore, the combination of the Borgstahl, Hashimoto and Joao references also does not render obvious the subject matter of claims 5, 7, 8 and 15 for the reasons set forth above. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

Finally, in this amendment, new claims 36 and 37 have been added. New claim 36 is a method claim, including the steps of method claim 18, but adding the step of automatically displaying a home page of the household control system and automatically triggering at least one appliance control command when a distance between the mobile data terminal and the household control system falls below a predetermined limit. New claim 37 is directed to a terminal with similar features to that of claim 36.


For the reasons set forth above, the Applicant respectfully submits that claims 18-27 and 29-37 are patentable over the cited references. The Applicant further requests withdrawal of the rejection under 35 U.S.C. 103 and reconsideration of the claims as herein amended.

In light of the foregoing arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss

appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



Michael J. Striker  
Attorney for Applicant  
Reg. No.: 27233  
103 East Neck Road  
Huntington, New York 11743  
631-549-4700